

REMARKS

Prior to entry of this Amendment:

- Claims 1 – 43 were pending in the present application.

Upon entry of this Amendment:

- Claims 1, 17, 22, 31 and 38-41 have been amended;
- Claims 1 – 43 will be pending; and
- Claims 1, 20, and 38-43 will be the only independent claims.

A. Claim Objections

Claims 22 and 31 were objected to for being incomplete. Due to a clerical error, some verbiage was inadvertently omitted, as the Examiner recognized on page 2 of the Office Action. Thus, Claims 22 and 31 have been amended to include the same language appearing in Claims 3 and 12. No new matter has been added.

In view of the above amendments and remarks, we respectfully request withdrawal of the objections to Claims 22 and 31.

B. Claim Rejections Under 35 U.S.C. §101

The Examiner rejected claims 1-37 for allegedly being directed to non-statutory subject matter. We respectfully traverse this rejection.

35 U.S.C. §101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

“The use of the expansive term “any” in §101 represents Congress’s intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in §101 and the other parts of Title 35.” *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994) (*en banc*). Applicants understand that the Supreme Court has “... recognized limits to §101 and every discovery is not embraced within the statutory terms. Excluded from such patent protection are laws of nature, physical phenomena and abstract ideas.” *Diamond v. Diehr*, 450

U.S. 175, 185, 209 USPQ 1, 7 (1981). But we respectfully assert that Claims 1-37 do not fit into one of the excluded categories, and in fact are directed to a new and novel article of manufacture.

In particular, independent Claims 1 recites a billing statement that includes a description of a transaction, and the novel feature of: *an offer pointer associated with a transaction, wherein the offer pointer comprises information for use to review an offer*. As explained in the present application, the offer pointer may comprise a toll-free telephone number or hyperlink positioned adjacent the transaction, and may be customized based on details of the transaction (See Specification, page 4, line 28 to page 5, line 6). Such a billing statement is novel and advantageous, not only because such offers can be tailored to the consumer, but also because complex details of the offer can be provided elsewhere and thus do not have to take up any space on the billing statement (Specification, page 5, lines 7-14). Similarly, independent Claim 20 is directed to a billing statement that includes a description of a transaction, and the novel feature of: *an offer associated with the transaction, wherein the offer is an offer to reduce an amount owed associated with the transaction*. In various embodiments, the consumer must perform a further action to receive the details of the offer associated with a transaction, and to accept one or more of the offers.

The Applicants respectfully assert that such a billing statement is not a mere arrangement or compilation of data, but rather is an article of manufacture that includes the novel feature of an offer pointer associated with a transaction, or a specific type of offer associated with a transaction.

The Examiner has supported his §101 rejection by stating that:

“The claimed billing statement is merely a document containing information, presumably about a monetary amount owed by a receiving party. Therefore, none of the claims include any functional language describing actions to be taken nor procedures to be followed in order to produce the invention, and thus are considered non-functional descriptive material.” (Office Action, page 3)

Apparently, the Examiner believes that the “descriptive material” will not distinguish the claimed invention from the prior art in terms of patentability, and appears to be alluding to a concept commonly referred to as “the printed matter exception to patentability”. The Federal Circuit has stated: “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. In other words, printed matter of a claim will not be given patentable weight if the printed

matter is not functionally related to the substrate on which it is printed.” *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1994)

This exception applies when the *differences* between an invention and the prior art cited against it *reside in the content of the printed matter*. If the differences do reside in the printed matter, the differences between the invention and the prior art “cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.” *Id.* As the Federal Circuit made clear in *Gulack*, it must first be determined whether the printed matter is functionally related to the substrate. If it is, it must be given patentable weight. In *Gulack*, the Federal Circuit reversed the rejection of the claims under §103 because it found that the printed matter in question was functionally related to the substrate and because the prior art failed to disclose or suggest the printed matter claimed.

First, the printed matter exception is inapplicable to the pending claims because (i) no printed matter is being claimed, and (ii) the differences between the invention and the prior art lie in limitations of the claims other than any printed matter. Regarding reason (i), the Examiner appears to be stating that the term “billing statement” is considered to be the printed matter or non-functional descriptive material being claimed. This is incorrect. The billing statement is an article of manufacture that is involved in the method of the claim. Regarding reason (ii), as explained below, the prior art does not suggest various limitations of the pending claims. These limitations are not directed to printed matter, and thus the differences between the prior art and the claimed subject matter do not reside in the printed matter.

Moreover, the Examiner’s reliance on *In re Warmerdam* is misplaced. In that case, claims 1-4 and 6 were rejected for lack of statutory subject matter under §101. We note that claims 1-4 and 6 recited methods for generating a “data structure” that represents the shape of a physical object in a position and/or motion control machine as a hierarchy of bubbles (see *In re Warmerdam*, 33 F.3d 1354, 1355 (Fed. Cir. 1994)). In upholding the decision of the Patent and Trademark Office Board of Appeal that the Appellant’s method claims 1-4 and claim 6 were unpatentable, the Court considered computer-related cases for guidance (*Id.* at 1359) and then stated:

“The body of claim 1 recites... steps [that] describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic “abstract idea”. As the Supreme Court has made

clear, “an idea of itself is not patentable” (citations omitted); taking several abstract ideas and manipulating them together adds nothing to the basic equation.” *Id.* at 1360.

First, pending Claims 1-37 are not method claims, and are not necessarily computer-related. Second, we respectfully assert that these claims do not recite an abstract idea or ideas. In fact, independent claim 1 pertains to a billing statement that includes the novel feature of an offer pointer, and independent claim 20 includes a similar novel feature of an offer associated with a transaction, wherein acceptance of the offer would reduce an amount that is owed associated with the transaction. Consequently, *In re Warmerdam* is inapplicable.

Accordingly, for at least the reasons set forth above, we respectfully assert that independent Claims 1 and 20, and dependent Claims 2-19 and 21-37, recite statutory subject matter. Thus, we respectfully request withdrawal of the rejection of Claims 1-37 under 35 U.S.C. §101.

C. Claim Rejection Under 35 U.S.C. §112, First Paragraph

Claims 38 and 39 stand rejected under 35 U.S.C. §112, first paragraph, for allegedly being non-enabling. Specifically, the Examiner categorized these two claims as being single-step process claims and, as best understood, then rejected them for being of “undue breadth”. Although the Applicants disagree with such an assessment, Claims 38 and 39 have been amended to more distinctly claim the invention. In particular, Claim 38 has been amended to recite “determining an offer pointer associated with the transaction” that is “for use to review an offer”, and Claim 39 has been amended to recite “determining an offer associated with the transaction”. Support for such cosmetic changes can be found, for example, in the specification on page 45, line 26 to page 46, line 27. No new matter has been added.

In view of the above amendments and remarks, the Applicants respectfully request withdrawal of the 35 U.S.C. §112 rejections of Claims 38 and 39.

D. Claim Rejections Under 35 U.S.C. §102(b)

Claims 1, 2, 10-13, 20, 21, 23, 30, 31, 35-43 stand rejected for allegedly being anticipated by page 331 of Carson et al., “*College Accounting, Eighth Edition*” published by South-Western Publishing Company (hereinafter “Carson”). The Applicants respectfully traverse this rejection.

Applicants note that Claims 1, 17, 40 and 41 have been amended to more distinctly claim the invention. In particular, the phrase “that may be used” has

been replaced with “for use”, such that these claims now recite either an offer pointer or a second offer pointer that includes information *for use to review an offer*. Support for these cosmetic changes can be found, for example, in the application on page 4, line 25 to page 5, line 6. No new matter has been added.

Page 331 of Carson is an example of a “Statement of Consignment Sales” (see bottom of page), which is a monthly statement from “Mattoon Electric Co.” to “Windsor Hardware Co.”. It includes a balance amount previously forwarded from a previous statement (in line 1 of \$348.92), and a list of charges or credits (see list under line 2) that totals \$146.94. When these two amounts are added, they total \$495.86, which appears in line 3 as the “total accountability” amount. A “working stock” amount of \$327.39 is then subtracted from the total accountability amount in line 3 to arrive at the list sales for the month of \$168.47 shown in line 4. In line 5, a 30% compensation amount of \$50.54 (equal to 30% of \$168.47) is calculated, and this amount is then subtracted from the list sales amount of \$168.47 to arrive at a net of \$117.93 in line 7. Two percent of this amount (\$2.36) appears in line 8, which is categorized as “special compensation”, and this small amount is subtracted from the net of \$117.93 to arrive at the net amount of \$115.57 in line 9. We note that an explanation of the “special compensation” appears at the bottom of the statement, and a discount on the net amount is automatically taken by the Agent if he simply sends his check for payment by the seventh day of each month. In this example, since there are no “other charges and/or credits” listed in line 10, the net amount of \$115.57 is also the remittance due, as shown in line 12.

Applicants respectfully assert that there is no “offer pointer” illustrated anywhere on the Carson statement. Independent Claim 1 recites *an offer pointer associated with a transaction, wherein the offer pointer comprises information for use to review an offer*. In addition, independent claims 38, 40 and 41 recite “*determining an offer pointer*”. In stark contrast, the Carson statement is merely what it purports to be, a statement of charges and credits and an amount due for remittance. Typically, all of the charges that appear in such a statement are predetermined by contractual agreement, wherein the exact amounts change from month to month only because the type and number of items sold by the Mattoon Electric Co. changes. The two percent discount awarded to an Agent for paying his bill on time is not comparable to the offer pointer as recited in the present claims, as the discount is a static announcement that is associated with the billing statement as a whole and is available every billing cycle. Thus, Carson does not teach or suggest a billing statement that includes an offer pointer *associated with a transaction, wherein the offer pointer comprises information for use to review an offer*. Furthermore, Carson does not teach or suggest a method that includes *determining an offer pointer associated with a transaction, for use to review an*

offer as recited by independent Claims **38, 40 and 41**. We note that the Examiner failed to indicate what portion or portions of Carson he believes illustrates such features, and the Applicants respectfully assert that he cannot do so because they are not included anywhere in Carson's "Statement of Consignment Sales".

Similarly, independent Claims **20 and 39** recite that the offer comprises *an offer to reduce the amount owed associated with the transaction*. The Applicants respectfully submit that the Carson statement fails to teach or suggest this feature. We submit that the entries on the "Statement of Consignment Sales" that are subtracted from other amounts are not "offers" but rather are contractual amounts (line 4, "less working stock", line 6, "less 30% basic compensation", and line 8 "less 2% special compensation"). Accordingly, Carson fails to teach an "offer to reduce an amount associated with a transaction" as recited by independent Claims **20 and 39**.

In addition, independent method Claim **42** recites *receiving from a customer an offer pointer associated with a transaction, and then transmitting an offer to the customer that is associated with the offer pointer*. Independent Claim **43** recites *receiving a request from a customer to review an offer pointer associated with a transaction... the offer to reduce an amount owed by the customer, and then transmitting the offer to the customer, and determining a new amount owed by the customer if the offer is accepted by the customer*. The Applicants respectfully submit that Carson fails to teach (or even suggest) such processes, and that the Examiner has failed to point out any verbiage or teaching in the "Statement of Consignment Sales" of Carson that is even remotely related to the use of such procedures. Accordingly, as Carson fails to teach these features, independent Claims **42 and 43** are not anticipated.

In view of the above remarks, the Applicants respectfully assert that independent Claims **1, 20 and 38-43** are not anticipated. In addition, since dependent Claims **2, 10-13, 21, 23, 30, 31 and 35-37** all directly or indirectly depend on either of independent Claims **1 or 20**, these claims should also be allowable for at least the same reasons.

In view of the above remarks, the Applicants respectfully request withdrawal of all of the 35 U.S.C. §102(b) rejections of the pending Claims.

E. Claim Rejections Under 35 U.S.C. §103(a)

Dependent Claims **3-9, 14-19, 22, 24-29 and 32-34** stand rejected for allegedly being unpatentable over Carson. We respectfully traverse these 35 U.S.C. §103(a) rejections.

We note that independent claims **1** and **20** are patentably distinct over Carson for at least the reasons recited above in Section D, which will not be repeated here. Since dependent Claims **3-9, 14-19, 22, 24-29 and 32-34** all directly or indirectly depend upon Claims **1** and **20**, these claims should also be allowable for at least the same reasons.

We also respectfully assert that a *prima facie* case of obviousness has not been made for any claim in light of Carson. In particular, the Examiner has neither

- (i) defined a level of ordinary skill in the art, nor
- (ii) clearly indicated any evidence in support of such a finding.

Such findings are necessary in assessing obviousness. M.P.E.P. § 2141.03.

Because a determination has not been made as to the level of ordinary skill, the Examiner (i) cannot have determined the scope and content of the prior art objectively, i.e., from the point of view of the hypothetical person having ordinary skill in the art at the time of invention, and thus (ii) cannot have determined the differences between the cited reference and the claims objectively.

Furthermore, there is no clear indication, with respect to each rejected claim, of support in the record for any findings under the required Graham factual inquiries: (i) the level of ordinary skill in the pertinent art; (ii) the scope and contents of the prior art; (iii) the differences between the prior art and the claims in issue; and (iv) any evidence of secondary considerations. Consequently, a *prima facie* conclusion of obviousness cannot be factually supported with respect to any claim.

For example, without resolving the level of ordinary skill in the art, the Examiner has no factual support for an assertion that either (a) a claimed feature or (b) a motivation to combine / modify references may be found objectively either (i) in any references themselves, (ii) in the knowledge generally available to one of ordinary skill in the art, or (iii) in the nature of the problem to be solved.

For at least these reasons, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for any pending claim.

In addition, a *prima facie* case of obviousness has not been established for Claims **3-9, 14-19, 22, 24-29 and 32-34** (or any other claim) in light of Carson because there is no substantial evidence in the record to support the following assertions:

- a) That it is old and well known to present billing and other financial information as viewable electronic data (Office Action, page 7, with

regard to claims 3 and 22). There is no evidence in support of this assertion, and we traverse the “Official Notice” taken by the Examiner concerning this issue. There is no disclosure in Carson, the only reference cited, to support the notion that a billing statement could include viewable electronic data. Carson merely illustrates a “Statement of Consignment Sales” for use by an Agent to record sales and to remit payment to the consignor. Since there is no support in the record, then no *prima facie* case has been made. We cannot evaluate what has not been made of record.

- b) That it would have been obvious to one of skill in the art at the time the invention was made that the offer pointer would comprise “appropriate instructions” based on the method by which the customer is to receive an offer (Office Action, pages 7-8, with regard to claims 4-9 and 24-29). Again, there is no disclosure in Carson to support such an assertion, and because there is no support in the record for it, no *prima facie* case has been made.
- c) That it would have been obvious to one of skill in the art at the time the invention was made to provide the same or different terms for each transaction listed on Carson’s billing statement (Office Action, page 9, with regard to claims 17 and 32). Yet again, there is no teaching or even a suggestion in Carson to support such an assertion, and because there is no support in the record for it, no *prima facie* case has been made.
- d) That Carson discloses that the second offer is the same as the first offer (Office Action, page 9, with regard to claims 18 and 33). We respectfully assert that Carson neither teaches nor suggests anything of the sort, and thus there is no support for this assertion. Accordingly, no *prima facie* case has been made.
- e) That it is a “design choice” to place an offer pointer adjacent to a description of a transaction on the billing statement (Office Action, page 9, with regard to claims 19 and 34). Carson does not teach or suggest placement of anything, and thus there is no support for this assertion and no *prima facie* case has been made.

We respectfully assert that the Section 103(a) rejection in light of Carson and either the Examiner’s use of “Official Notice”, or some other criteria (which the Examiner has not defined) for what is considered to be “known” in the art, cannot stand. As noted above, the obviousness rejections are not supported with substantial evidence of any motivation to combine Carson with any other

reference, or anything else, in a manner that would provide for all of the cited features of any claim. Therefore, a *prima facie* case of obviousness has not been established.

We respectfully assert that the only cited reference (Carson) does not teach or suggest the billing statement as recited in Claims 1-37, or the methods recited by Claims 38-43. Thus, at least for the reasons set forth above, we submit that all of the pending Claims 1-43 are patentably distinct from Carson.

The prior art made of record but not relied upon by the Examiner has not been discussed herein, as none of those references have been applied to any of the pending claims.

In view of the above remarks, the Applicants respectfully request withdrawal of all of the 35 U.S.C. §103(a) rejections and allowance of the present application.

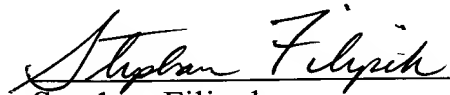
F. Conclusion

We respectfully submit that Claims 1-43 are now in condition for allowance, and the Examiner's early re-examination and reconsideration are respectfully requested. If there are any questions remain regarding the present application, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Stephan Filipek at telephone number (203) 461-7252 or via electronic mail at sfilipek@walkerdigital.com.

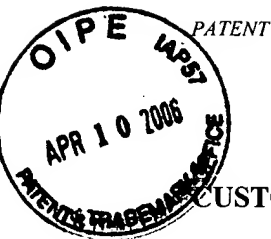
Submitted herewith is a Petition for a one-month extension of time to respond along with the required fee, and no other fee is believed to be due in connection with this amendment. The United States Patent and Trademark Office is hereby authorized to charge any fee associated with this case, throughout the pendency of the case, to Deposit Account No. 50-0271.

April 6, 2006
Date

Respectfully submitted,



Stephan Filipek
Attorney for Applicants
Registration No. 33,384
sfilipek@walkerdigital.com
(203) 461-7252 /voice
(203) 461-7300 /fax



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Applicants: Walker et al.
Application No.: 09/855,300
Filed: May 15, 2001
Title: SYSTEM FOR PROVIDING OFFERS USING A BILLING
STATEMENT
Attorney Docket No. 00-030

Group Art Unit: 3622
Examiner: MYHRE, James W.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**NOTIFICATION OF LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
PURSUANT TO 37 CFR 1.27 (g) (2)**

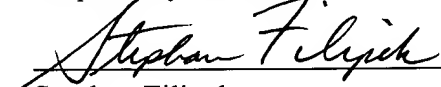
Dear Sir:

Please change the fee status of the above-identified application from a small entity to a large entity. This notification is made pursuant to 37 CFR §1.27(g)(2). The assignee of the above-identified application no longer claims small entity status. Therefore, please change the fee status of the application to that of a large entity. Also, change the fee status of any continuing applications claiming benefit under 35 USC §§ 119(e), 120, 121, or 365(c).

If the Examiner has any questions about this status change, the Examiner is invited to contact the undersigned at (203) 461-7252. While no fees are believed due in connection with this paper, please charge any fees that may be required for this paper, or with any other papers filed in connection with this application to Deposit Account No. 50-0271. A duplicate copy of this sheet is enclosed for such purpose.

April 6, 2006
Date

Respectfully submitted,


Stephan Filipek
Attorney for Applicants
Walker Digital, LLC
Registration No. 33,384
(203) 461-7252/direct
(203) 461-7018/fax